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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/942,753

08/30/2001

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09/06/2006

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EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,753

Applicant(s)

HIMMEL ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,10-14,16,17,19-23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,10-14,16,17,19-23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-5, 7, 8, 10-14, 16, 17, 19-23, 25 and 26 have been examined.

Application 09/942,753 (INCENTIVE CALL MINUTES) has a filing date 08/30/2001.

Response to Amendment

2. In response to Non Final Rejection filed 03/23/2006, the Applicant filed an Amendment on 06/23/2006, which amended claims 1, 10, 19 and cancel claims 6, 9, 15, 18, 24 and 27.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, 10-14, 17, 19-23 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Racov (US 2002/0152179).

As per claims 1, 10 and 19, Racov teaches:

A method comprising:

reading an identification code identifying an account of telephone call minutes from an identification device at a point-of-sale terminal (see paragraph 121 "PIN number identified by the mobile phone number or CLI), the point-of-sale terminal including a

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display for displaying information about the commercial transaction to both an operator of the point-of-sale terminal and a user of the identification device (see paragraph 116);

processing the commercial transaction at the point-of-sale terminal (see paragraphs 121-122; 69 “merchant confirms the funds transfer with the customer independently of the ICOM payment server”;

in response to the processing of the commercial transaction, crediting the account of telephone call minutes with a number of additional call minutes commensurate with the commercial transaction by sending both the number of additional call minutes and the identification code from the point-of-sale terminal to a telephone service provider of the user (see paragraph 72, “payer id data requires calling line identification where the ICOM server receiving the incoming customer call can detect the number assigned to the mobile communications device originating the call”; paragraph 80 “ICOM communicates with Telco to receive customer CLI information specific to the customer’s mobile communication devices, which is relevant to the Payer_ID”).

As per claims 2, 11 and 20, Racov teaches:

The method of claim 1, wherein the account of telephone call minutes is an account of mobile telephone airtime minutes (see paragraph 101).

As per claims 3, 12 and 21, Racov teaches:

The method of claim 1, wherein the account of telephone call minutes is an account of pre-paid long-distance call minutes (see paragraph 101).

As per claims 4, 13 and 22, Racov teaches:

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The method of claim 1, wherein the commercial transaction is a purchase (see paragraphs 105-106).

As per claims 5, 14 and 23, Racov teaches:

The method of claim 4, wherein the number of additional call minutes is commensurate with the amount of the purchase (see paragraph 100).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Racov (US 2002/0152179).

As per claims 7, 16 and 25, Racov teaches:

The method of claim 1, but does not expressly teach wherein the commercial transaction is a rental agreement. Racov teaches that his system provides customers with a loyalty bonus for using the remote payment account, which includes additional airtime minutes from the mobile company activating the communication devices and where said bonus is based upon volume of transaction activity or the value of such transactions (see paragraph 32). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a rental

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agreement would be a merchant's transaction and therefore, said transaction would help customers earn airtime minutes loyalty bonus. The type of merchant would not patentably distinguish the claimed invention from the prior art.

Claims 8, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Racov (US 2002/0152179) in view of Sanchez (US 2002/0174011).

As per claims 8, 17 and 26, Racov teaches:

The method of claim 1, but fails to teach wherein the commercial transaction is a product test. However, Sanchez teaches that incentive programs offer awards and incentives to modify behavior of individual consumers and to direct the consumer to some pre-determined action, such as purchase of products or services upon visiting a retailer, viewing advertising, testing a product or the like. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that merchants participating in the Racov's system would utilize customers' loyalty data to determine if said customers fall into said merchants' preferred customer profiles in order to notify said customers of offers such as testing merchants' products or services which would increase said customers awareness of said merchant's products or services and which would increase the probability that said customers would buy said products or services.

Response to Arguments

5. Applicant's arguments filed 06/23/2006 have been fully considered but they are not persuasive. The Applicant argues that Racov does not teach "reading an identification code identifying the account of telephone call minutes from an

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identification device at a point-of-sale terminal". The Applicant further argues that the cited reference expressly teaches away from using an identification device at a point of sale terminal, due to the associated problems as it requires a user to be physically present and high transaction costs. Instead, the Applicant argues that Racov describe use of a remote device for making remote payments. The Examiner answers that Racov teaches in paragraph 71 that the customer's mobile telephone number (i.e. CLI) and PIN number serves as a payer ID data which is used to identify a customer placing a transaction in a point of sale terminal¹ (i.e. merchant's webpage)². Furthermore, said CLI number is linked to the Telco account, which would receive bonus free airtimes minutes based upon the value of transactions³. Therefore, contrary to Applicant's argument, Racov's customer mobile device transmits an identification code (i.e. CLI and PIN number), which is linked to the customer's telephone minutes award account. Also, Applicant is arguing about limitation not stated in the claims when he argues that Racov teaches away from using an identification device at a point of sale terminal, due to the associated problems as it requires a user to be physically present and high transaction costs. Applicant's claims do not mention that a user needs to be physically present, neither defined said term.

The Applicant further argues that contrary to Applicant's claimed invention, Racov does not provide direct access from the point of sale terminal to the telephone service provider. The Examiner answers that Applicant's claim 1 recites "sending both the number of additional call minutes and the identification code from the point-of-sale

¹ Racov paragraphs 71, 80 and 120-121

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terminal to a telephone service provider". Racov teaches a system that calculates the value and volume of a transaction in a point of sale terminal and based upon said transaction data in said point of sale terminal, the Racov system updates a customer's telco account with earned fee airtimes minutes. Furthermore, nowhere in Applicant's claims is defined the term "direct", therefore, contrary to Applicant's argument, Racov teaches Applicant's limitation.

The Applicant argues that the teaching of Racov are keen on providing a separate third party system (ICOM), therefore not teaching the Applicant's claimed invention. The Examiner answers that Racov teaches that "ICOM can include a physically separate payment server or its functionality may be incorporated directly into a software package ideally suited to be installed on a remote computer or communication devices"⁴ and also teaches that "ICOM could be an entity that exists as a direct part of, for example, the Bank or the Telco". Therefore, contrary to Applicant's argument, the ICOM system does not have to be a separate third party system.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

² Racov paragh 116

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

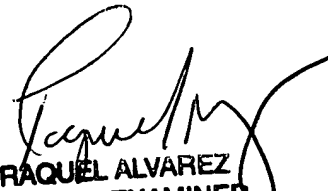
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
August 27, 2006


RAQUEL ALVAREZ
PRIMARY EXAMINER

³ Racov paragraph 80, 106

⁴ Racov parg 146